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REMARKS

Claims 2-36 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

Applicants would like to thank the Examiner for the telephone interview on August 25, 2004, in which the rejection of the claims under 35 U.S.C. §112, first paragraph, and over the prior art were discussed as outlined below.

Claims 2-9 and 14-36 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. According to the Office Action, claims 2-9 and 14-36 contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention because the terms "mirror element" and "reflective element" do not appear anywhere in the instant specification. However, the present application discloses in paragraph 50 that:

The mirror subassembly 24 (Fig. 6) includes a front glass element 51 having a thickness of about 1.6-mm or that is more preferably about 1.1-mm or less, and a rear glass element 52 having a thickness of about 2.2-mm to 1.1-mm or that is more preferably about 1.6-mm. An electrochromic (EC) substance 53 is located between the glass elements 51 and 52. A reflector layer 54 is applied to a rear of the rear glass element 52 (i.e. a fourth surface reflector) (as illustrated) or to a front of the rear glass element 52 (i.e. a third surface reflector). It is contemplated that the EC substance can be a solution phase material, a solid phase material, a gel material, or a hybrid thereof or any other material that is darkenable in a controlled manner. An electrochromic mirror subassembly 24 of interest having low-thickness glass elements is described in detail in U.S. Patent No. 6,195,194, which patent is incorporated in its entirety herein by reference.

Clearly, the present application discloses how to make and use a reflective element and a mirror element. While the terms "mirror element" and "reflective element" in the claims do not require that the mirror element and reflective element be electrochromic mirrors, an electrochromic mirror is definitely included in the terms "mirror element" and "reflective element." Furthermore, as discussed during the telephone interview, the Examiner acknowledged that an electrochromic mirror is enabled by the present specification.

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Accordingly, the present application enables one skilled in the art to make and use a mirror element and a reflective element as recited in the claims.

Claim 11 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. According to the Office Action, claim 11 recites the limitation "a panel" and there is insufficient antecedent basis for this limitation in the claim. According to M.P.E.P. §2173.05(e), a claim term lacks antecedent basis when the claim refers to "said element" or "the element" where the claim contains no earlier recitation or limitation of an element and where it would be unclear as to what element the limitation was making reference. Accordingly, the limitation "a panel" in claim 11 does not need antecedent basis in the claim because the limitation "a panel" is first introduced in the second line of the claim. Accordingly, claim 11 is definite.

Claims 19-28 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention because the limitation "the member comprising" in the third line of claims 19 and 24 has insufficient antecedent basis. The element "the member" has been changed to be "the apparatus," thereby obviating the 35 U.S.C. §112, second paragraph, rejection of claims 19-28. Accordingly, Applicants submit that claims 19-28 are definite.

Claims 2-5, 7-10, 12-14, 29-32 and 34-36 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,426,485 to Bulgajewski et al. According to 35 U.S.C. §102(b), a person shall be entitled to a patent unless the invention was patented or described in a print publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. The Bulgajewski et al. '485 patent has a filing date of July 31, 2001. The present application has a priority date of May 21, 2001. Accordingly, the present application was filed before the Bulgajewski et al. '485 patent such that the Bulgajewski et al. '485 patent is not prior art under any subsection of 35 U.S.C. §102. This was pointed out to the Examiner in the telephone interview and acknowledged by the Examiner as being correct. Accordingly, claims 2-5, 7-10, 12-14, 29-32 and 34-36 are in condition for allowance.

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As a final note, Applicants would like to point out that claims 10, 12 and 13 have only been rejected over the Bulgajewski et al. '485 patent. Since the Bulgajewski et al. '485 patent is not prior art as outlined above, claims 10, 12 and 13 should now be allowed.

All pending claims 2-36 are in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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